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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Radhika AGGARWAL, et al.	:	Confirmation Number: 2419
	:	
Application No.: 10/041,141	:	Group Art Unit: 2178
	:	
Filed: January 3, 2002	:	Examiner: T. Huynh
	:	

For: INLINE ERROR HIGHLIGHTING

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellants' Appeal Brief in support of the Notice of Appeal filed May 24, 2006.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 13, 2006

Respectfully submitted,

/s/ Scott D. Paul

Scott D. Paul

Registration No. 42,984

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CUSTOMER NUMBER 46320

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APPEAL BRIEF

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Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed May 24, 2006, and in response to the Pre-Appeal Brief Conference decision dated June 13, 2006, wherein Appellants appeal from the Examiner's rejection of claims 1-10.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on January 3, 2002, at Reel 012482, Frame 0318.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-10 are pending in this Application and have been finally rejected. It is from the final rejections of claims 1-10 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Final Office Action dated February 24, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1 and 6 are respectively directed to an inline error notification method and machine readable storage. Referring to Figure 3 and pages 10-12 of Appellants' specification, a validation error is detected in block 310 based upon a value provided through an input-element in a markup specified form. In block 314, a suitable textual error message is selected based upon the type of validation error which has occurred. In block 316, markup specifying the row is inserted into the markup specifying the form at a position which is proximate to the input-element which gave rise to the validation error. Also in block 316, the textual error message selected in block 314 is inserted into a row. To visually distinguish the inline error notification from the rest of the form, the background of the row assumes a color which differs from the colors of the input element and its surroundings. In step 318, an anchor tag is applied proximately to the input-element. In consequence, when the page containing the form is reloaded, the anchor is specified in the URL causing the page to scroll to a position which is proximate to the input-element.

VI. ISSUES TO BE REVIEWED ON APPEAL

1. Claims 1-2, 5-7, and 10 were rejected under 35 U.S.C. § 103 for obviousness based upon Upton et al., U.S. Patent Publication No. 2003/0104884 (hereinafter Upton), in view of Jeffries et al., U.S. Patent No. 6,094,529 (hereinafter Jeffries), and Homer et al., "Instant HTML," copyright 1997, pages 88-101 (hereinafter Homer); and

2. Claims 3-4 and 8-9 were rejected under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries and Homer and further in view of Hartmann, U.S. Patent No. 6,615,226.

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1-2, 5-7, AND 10 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON UPTON IN VIEW OF JEFFRIES AND HOMER

For convenience of the Honorable Board in addressing the rejections, claims 2, 5-7, and 10 stand or fall together with independent claim 1.

On page 3 of the Request for Reconsideration filed December 2, 2005, Appellants noted that the filing date of the present application is January 3, 2002, whereas the filing date of Upton is October 15, 2002. Thus, the Examiner cannot rely upon the teachings within the disclosure of Upton for the rejection, but instead, the Examiner must rely upon the disclosure in a U.S. Provisional Application upon which Upton claims priority.

Appellants also cited M.P.E.P. § 2136.03(III) for the proposition that the filing date of the provisional application can be relied upon by the Examiner only "if the provisional application(s)

properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." On page 4 of the Request for Reconsideration, Appellants also cited 37 C.F.R. § 1.104(c)¹ in support of the argument that the Examiner must clearly designate the teachings in the provisional application being relied upon the statement of the rejection. Since the Examiner had not cited to the provisional application, that burden had not been met.

The Examiner's response to this argument is found on page 7 of the Final Office Action dated February 24, 2006, in which the Examiner asserted the following:

It is noted that Upton claims priority filing date for U.S. Provisional Applications 60/347,919 and 60/347,901. The 60/347,901 provisional application properly supports the subject matter relied upon by the Examiner to make the rejection of claims 1-2, 5-7 and 10 (See 60/347,901; pages 8-3 to 8-9).

The Examiner's reference to "pages 8-3 to 8-9" of the '901 provisional application, however, still does not meet the requirements of 37 C.F.R. § 1.104(c), which requires that "the particular part relied on must be designated as nearly as practicable."

It is practicable for the Examiner, for each of the claimed elements, to specifically identify each feature, within the '901 provisional application, being relied upon to teach each of the particular claimed elements. For example, the Examiner can "specifically identify" a feature, corresponding to the claimed element, within the applied prior art by identifying a reference numeral associated with the feature. In addition to or alternatively, the Examiner may cite to a brief passage (i.e., 1 or 2 lines or even a portion of a line) within the applied prior art that

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

identifies the feature that corresponds to the claimed element. However, merely citing seven whole pages to disclose multiple claimed elements does not designate "as nearly as practicable," the particular features within the '901 provisional application being relied upon by the Examiner in the rejection.

Although referring to an rejection under 35 U.S.C. § 103, in the unpublished opinion of Ex parte Pryor², the Board of Patent Appeals and Interferences recognized the necessity for an Examiner to point out the "corresponding elements between the instant claims and the applied reference" so as establish a proper rejection. Specifically, the Board wrote:

At the outset, we note the examiner has been of little help in particularly explaining the rejections on appeal. A mere statement that claims stand rejected "as being clearly anticipated by" a particular reference, without any further rationale, such as pointing out corresponding elements between the instant claims and the applied reference, fails to clearly make out a prima facie case of anticipation. (emphasis in original)

Notwithstanding the Examiner's failure to meet the requirements of 37 C.F.R. § 1.104(c), Appellants note that the Examiner is relying upon the '901 provisional application to teach the claimed "selecting error text corresponding to said validation error and inserting said selected error text in said row" (see second paragraph on page 3 of the Final Office Action in which the Examiner asserts that Upton discloses this feature). Although the Examiner has asserted that this feature is disclosed in pages 8-3 to 8-9 of the '901 provisional application, Appellants respectfully disagree.

² Appeal No. 1997-2981.

Upon reviewing pages 8-3 to 8-9 of the '901 provisional application, Appellants have been able to identify the following discussions of "error messages" within the '901 provisional application:

- the third and fourth enumerated paragraphs on page 8-3;
- the section entitled "Word and Its Descendants" on page 8-5; and
- the section entitled "AbstractInputTagSupport and Its Descendants" on page 8-6.

Upon reviewing these passages, Appellants note that none of these passages support the Examiner's assertion that the '901 provisional application identically discloses the claimed "selecting error text corresponding to said validation error and inserting said selected error text in said row."

Page 8-3 of the '901 provisional application teaches that the "error message should be localized for the user's preferred locale if the web application supports multiple locales" and that "[t]he form will need to be re-displayed to the user with a localized error message at the top." Neither of these passages teach associating the error text to the validation error. Instead, the error message is based upon the "user's preferred locale" and not on the validation error.

Page 8-5 teaches that "the Word object uses a message bundle to retrieve an internationalized/localized error message for the field." Similarly, page 8-6 teaches "[d]isplaying a localized error message next to the form field if the supplied value is invalid." Comparable to the passage on page 8-3, these passages in pages 8-5, 8-6 do not teach that selecting the error text so that the error text corresponds to the validation error.

Moreover, although not explicitly argued by the Examiner, Appellants posit that the Examiner may be asserting that the '901 application inherently teaches that error text is selected so as to correspond to a validation error, as claimed. If true, The Examiner's reliance upon the doctrine of inherency to disclose this feature would be misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.³ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁴ This burden has not been met, and thus, the Examiner has not established that this limitation is inherently disclosed by the '901 application.

Moreover, one can readily envision a situation in which the text of the error message is not necessarily selected so as to correspond to the validation error. For example, the text of the error message can always be "Error," in which situation the text of the error message has not been selected (i.e., chosen) to correspond to the validation error. Since the text of the error message is not necessarily associated with the validation error, an assertion that the '901 application inherently discloses the missing limitation would not be proper.

Therefore, for the reasons stated above, the '901 provisional application fails to explicitly or inherently teach the limitations for which the Examiner is relying on the '901 provisional

³ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁴ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

application to teach. Thus, even if one having ordinary skill in the art were motivated to modify the '901 provision application (i.e., Upton) in view of Jeffries and Homer, the claimed invention would not result. Appellants, therefore, submit that the rejection of claims 1-2, 5-6, and 10 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries and Homer is not viable.

**THE REJECTION OF CLAIMS 3-4 AND 8-9 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON UPTON IN VIEW OF JEFFRIES, HOMER, AND HARTMANN**

For convenience of the Honorable Board in addressing the rejections, claims 3-4 and 8-9 stand or fall together with independent claim 1.

Claims 3-4 and 8-9 respectively depend from independent claims 1 and 6, and Appellants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 6 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries and Homer. Specifically, even if the applied prior art were combined in the manner suggested by the Examiner, the claimed invention would not result since the Examiner has not established that the applied prior art teaches all of the claimed limitations recited in claims 1 and 6. The additional reference to Hartmann does not cure the deficiencies of the combination of Upton in view of Jeffries and Homer. Accordingly, the proposed combination of references would not yield the claimed invention. Appellants, therefore, respectfully submit that the imposed rejection of claims 3-4 and 8-9 under 35 U.S.C. § 103 for obviousness based upon Upton in view of Jeffries, Homer, and Hartmann is not viable.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. § 103 for obviousness based upon the applied prior art is not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

Date: July 13, 2006

Respectfully submitted,

/s/ Scott D. Paul

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

1. An inline error notification method comprising:

detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form;

inserting a row in said markup specified form in a position which is proximate to said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row;

selecting error text corresponding to said validation error and inserting said selected error text in said row;

further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element; and,

serving said markup specified form in a response to said form-based submit, said response referencing said anchor tag.

2. The inline error notification method of claim 1, further comprising the step of:

inserting an error image adjacent to said input-element.

3. The inline error notification method of claim 1, further comprising the steps of:

determining whether said markup specified form contained multiple views, one of said multiple views containing said input-element; and,

if it is determined that said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status.

4. The inline error notification method of claim 1, wherein said step of inserting a row in said markup specified form in a position which is proximate to said input-element comprises the step of:

inserting a row in said markup specified form in a position which is proximate to but below said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row.

5. The inline error notification method of claim 4, wherein said step of further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element comprises the step of:

further inserting an anchor tag in said markup specified form in a position which is proximate to but before said input-element.

6. A machine readable storage having stored thereon a computer program for performing inline error notification, said computer program comprising a routing set of instructions for causing the machine to perform the steps of:

detecting in a form-based submit, at least one validation error based upon a value provided through an input-element in a markup specified form;

inserting a row in said markup specified form in a position which is proximate to said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row;

selecting error text corresponding to said validation error and inserting said selected error text in said row;

further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element; and,

serving said markup specified form in a response to said form-based submit, said response referencing said anchor tag.

7. The machine readable storage of claim 6, further comprising the step of:

inserting an error image adjacent to said input-element.

8. The machine readable storage of claim 6, further comprising the steps of:

determining whether said markup specified form contained multiple views, one of said multiple views containing said input-element; and,

if it is determined that said markup specified form contains multiple views, identifying said one of said multiple views and setting said identified one of said multiple views to a visible status.

9. The machine readable storage of claim 6, wherein said step of inserting a row in said markup specified form in a position which is proximate to said input-element comprises the step of:

inserting a row in said markup specified form in a position which is proximate to but below said input-element, said row having a background color which differs from other colors which are visible in proximity to said inserted row.

10. The machine readable storage of claim 9, wherein said step of further inserting an anchor tag in said markup specified form in a position which is proximate to said input-element comprises the step of:

further inserting an anchor tag in said markup specified form in a position which is proximate to but before said input-element.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellants in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellants are unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.